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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,150	12/17/2001	Naoyuki Matsumoto	CANO:041	3168
7590 ROSSI & ASSOCIATES P.O. Box 826 Ashburn, VA 20146-0826		05/01/2007	EXAMINER SCHLACK, SCOTT A	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/023,150	MATSUMOTO, NAOYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Scott A. Schlack	2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/19/2007 has been entered.

#### ***Response to Amendment***

2. The examiner notes that in the amendment dated 02/19/2007 the applicant amends all independent claims 1, 11, 21, 31 and 32.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered but they are not persuasive. Specifically the applicant argues that the following claimed features of the newly amended independent claims 1, 11, 21, 31 and 32 are not met by the Eldridge et al. reference (US 6,397,261), "*determining the delivery destination of the document based on the delivery settings and the external device, which is the transmission source of the document, and for delivering the document to the determined delivery destination, which includes at least one of the servers or an external device that processes the delivered document*".

**Examiners Response:** determining a delivery destination of the document, based on the delivery settings (The examiner interprets the delivery settings to be those destination settings -requested services- of the received token (422 of Fig 8), by which

the token based server determines the delivery destination (442 of Fig 8), col 5, lines 34-46) and the external device which is the transmission source of the document (The examiner notes that the external device that is the source of the document could be scanner, 110 of Fig 1 , col 5, lines 41-45, wherein the document is stored as a scanned image type. The token information might require delivery to a fax service or printer service destination, thereby requiring conversion of the stored source data type to the output type specified (conversion of image data to print-ready data -via the appropriate driver, 148 and 150 of Fig 1-), col 5, lines 34-45 and 440 and 442 of Fig 8), and for delivering the document to the determined delivery destination (442 of Fig 8), which includes at least one of the servers or an external device that processes the delivered document" (102, 130 of Fig 1).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 11, 12, 21, 22, 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner notes that claim 1, as amended, recites the following limitation on line 9: "and the external device which is the transmission source of the document". There is insufficient antecedent basis for these limitations in the claim as claim 1 previously only a document that is said to be received from any of the plurality of external devices. For example the document could be interpreted by the examiner as being received from a plurality of sources opposed to

just one as indicated by the amendment. Claims 11, 21 31 and 32 similarly contain the same issues requiring revision as stated above for claim 1. The examiner notes that claim 2, as amended, recites "wherein the servers of the delivery destinations include". Claim 1 from which claim 2 depends, recites "wherein the delivery destination includes at least one of the severs or an external device". No where in claim 1 is there any reference to "servers of the delivery destinations". There is insufficient antecedent basis for this limitation in the claim. Claims 12 and 22 similarly contain the same issues requiring revision as stated above for claim 2.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6-13, 16-23 and 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261).

With respect to claim 1, Eldridge et al. discloses a document delivery apparatus (Token Enabled Server 126 comprising Document Delivery Server 138 of Fig 1) connected via a network (Intranet 116 and Internet 122 of Fig 1) to a plurality of external devices (102,110, 104, 112, 106,107, 118 and 126 of Fig 1) and a plurality of servers (104, 112,106, 107 and 126 of Fig 1), comprising: receiving means for receiving document a document generated from any of the external devices (**The examiner notes that the token-enabled server 126 includes a document capture server 134,**

**which stores and allows access to documents received from input devices such as scanner 110 of Fig 1: col 5, lines 41-45); delivery setting means for making delivery settings (col 5, lines 34-46 and 442 of Fig 8) using a managing tool, wherein the delivery settings store a relationship between the external devices and delivery destinations (The examiner notes that using the received token containing document source and destination information, the token enabled server 126 can convert the retrieved document to the type necessary for delivery to the destination, i.e. 148 and 152 of Fig 1, 440 and 442 of Fig 8, col 4, lines 55-58); and delivery means for determining a delivery destination of the document, based on the delivery settings (col 5, lines 34-46 and 422 of Fig 8) and the external device which is the transmission source of the document (The examiner notes that the external device that is the source of the document could be scanner, 110 of Fig 1, col 5, lines 41-45, wherein the document is stored as a scanned image type. The token information might require delivery to a fax machine or printer destination, thereby requiring conversion of the data type to the output type specified, col 5, lines 34-45 and 440 and 442 of Fig 8), and for delivering the document to the determined delivery destination (442 of Fig 8) and wherein the delivery destination includes an external device that processes the delivered document (Mobile Devices 118 of Fig 1).**

The examiner notes that the Token Enabled Server (126 of Fig 1) is said to include tokenaware services shown figuratively as a dotted rectangle encompassing various individual servers (col 4, lines 39-47). The examiner therefore interprets all functionality attributed to each encompassed server device to reside on a (one) Token

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Enabled Server. This interpretation is fully supported by Eldridge's invention (col 4, lines 39-47). The examiner notes that the Token Enabled Server receives a token representing document information from a requesting device (col 4, line 61 through col 5, line 4). The stored document being requested is said to have been originally captured from a scanner (110 of Fig 1) or a similar acquisition device (col 5, lines 41-45). The examiner views this as being equivalent receiving document information of a document generated from any of the external devices.

The examiner interprets a delivery setting means for making delivery settings as being necessarily inherent to the process of delivering the document, via an appropriate printer driver, to a selected document processing device (col 5, lines 34-46). The examiner further notes that in selecting the appropriate printer driver for a given document-processing device, the delivery servers (128 and 138 of Fig 1) make and utilize delivery settings. Also, the examiner notes that the in receiving the document from the Token Enabled Server, the requesting device (Mobile Device issuing the token) inherently processes the delivered document (i.e., storing it or viewing it).

Eldridge et al. does not disclose wherein the delivery destination includes at least one of the servers.

The examiner notes that Eldridge et al. does disclose a plurality of servers (Fig 1), and that it would have been obvious at the time of the invention for one skilled in the art to take Eldridge's Destination Device and combine it with his plurality of Server Devices, such that the Destination Device was said to include at least on of the servers.

The suggestion or motivation for doing so would have been to explicitly state that the delivery destination could be one of the servers.

Claim 11 recites identical features as claim 1 except claim 11 is a method claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 11.

Claim 21 recites identical features as claim 1 except claim 21 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 21. The examiner further, notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

Claim 31 recites identical features as claim 1 except claim 31 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 1 are also equally applicable to claim 31. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

With respect to claim 32 the examiner notes identical features to claim 1. Therefore, the explanation given above for claim 1 is also valid for claim 32.

With respect to claim 2, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the servers of the delivery destinations include (col 5, lines 34-45 and 442 of Fig 8) a document management server that manages documents (Network File Server 104 of Fig 1) and a mail server that delivers electronic mails (Network Email Server 112 of Fig 1).



Claim 12 recites identical features as claim 2 except claim 12 is a method claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 12.

Claim 22 recites identical features as claim 2 except claim 22 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 2 are also equally applicable to claim 22. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

With respect to claim 3, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the at least one server comprises a document management server that manages documents (104 Network File Server 104 and Shared Document Server 134 of Fig 1), and said delivery means comprises control means for delivering additional information acquired from the external device together with the document to said document management server as index information, and registering the document and the index information in said document management server (col 5, lines 34-46).

The examiner notes that the Document Delivery Servers (128 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax machine or a scanner (col 5, lines 41-45). The examiner further notes that in order to retrieve one of these documents utilizing token information, the document stored in the document management servers need to have reference token information. The examiner interprets this additional reference

information to be equivalent to index information, which is registered on the Document Delivery Servers in order to facilitate extraction of documents via tokens (col 7, lines 41-58).

Claim 13 recites identical features as claim 3 except claim 13 is a method claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 13.

Claim 23 recites identical features as claim 3 except claim 23 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 3 are also equally applicable to claim 23. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

1. With respect to claim 6, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery settings are set (418 and 442 of Fig 8) for each of the plurality of external devices (118 of Fig 1) that is a transmission sources of the document information (col 5, lines 34-45).

The examiner interprets the document information as being equivalent to the document tokens, which are sent from the mobile computing devices (118 of Fig 1) and further notes that it is necessarily inherent that the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1), which receives these tokens, set the corresponding delivery settings.

Claim 16 recites identical features as claim 6 except claim 16 is a method claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 16.

Claim 26 recites identical features as claim 6 except claim 26 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 6 are also equally applicable to claim 26. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

With respect to claim 7, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the delivery settings are made in accordance with instructions from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

The examiner notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) control delivery setting means, such that delivery settings are made in accordance with instructions (tokens) from any of said external devices (118 of Fig 1 and col 5, lines 34-45).

Claim 17 recites identical features as claim 7 except claim 17 is a method claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 17.

Claim 27 recites identical features as claim 7 except claim 27 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 7 are also equally applicable to claim 27. The examiner further notes that it is necessarily

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inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.\

With respect to claim 8, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the received document includes a fax document (Network Fax Server 106 of Fig 1 or a scan document (Scanner 110 of Fig 1, col 5, lines 41-45).

Claim 18 recites identical features as claim 8 except claim 18 is a method claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 18.

Claim 28 recites identical features as claim 8 except claim 28 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 8 are also equally applicable to claim 28. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

With respect to claim 9, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein, when the document is in a format different from one handled by the delivery destination, said delivery means converts the format of the received document to the one handled by the delivery destination (440 of Fig 8 and col 12, lines 53-62) and then delivers the converted (440 of Fig 8) document information to the delivery destination (442 of Fig 8 and col 12, lines 62-67).

Claim 19 recites identical features as claim 9 except claim 19 is a method claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 19.

Claim 29 recites identical features as claim 9 except claim 29 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 9 are also equally applicable to claim 29. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

With respect to claim 10, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the external devices (102, 110, 104, 112, 106, 107, 118 and 126 of Fig 1) each have at least one function of an image reading function (Scanner 110 of Fig 1) or a facsimile function (Network Fax Server 106 of Fig 1).

The examiner interprets the Scanner (110 of Fig 1) to inherently have an image reading function.

Claim 20 recites identical features as claim 10 except claim 20 is a method claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 20.

Claim 30 recites identical features as claim 10 except claim 30 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 10 are also equally applicable to claim 30. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

8. Claims 4, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Wells et al. (US 5,999,601).

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With respect to claim 4, Eldridge et al. discloses a document delivery apparatus according to claim 3, wherein the received document is a fax document received from a fax device(fax server 106 of Fig 1 and col 5, lines 41-45).

The examiner notes that the Document Delivery Servers (126 and 138 of Fig 1) store documents to the Network File Server or the Shared Document Server (104 and 134 of Fig 1) from external devices such as a fax server or a scanner (col 5, lines 41-45)

Eldridge et al. does not disclose wherein the additional information comprises at least one of information of a transmitter device of the received fax document, reception time information relating to the received fax document, or document page number information.

Wells et al. does disclose stored facsimile information comprising reception time information relating to the received fax document (col 4, lines 65-67 and col 5, lines 1-4).

Eldridge et al. and Wells et al. are analogous art, because they are from the same field of endeavor, namely Image Data Communications.

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 3, wherein the received document information comprises a fax document information received by fax, with Wells et al's stored facsimile information comprising reception time information relating to the received fax document such that the additional information disclosed in claim 3 comprises the reception time information.

The suggestion or motivation for doing so would have been to explicitly state that reception time information is included in the additional information.

Claim 14 recites identical features as claim 4 except claim 14 is a method claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 14.

Claim 24 recites identical features as claim 4 except claim 24 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 4 are also equally applicable to claim 24. The examiner further notes that it is necessarily inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

9. Claims 5, 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (US 6,397,261) in view of Adamske et al. (US 6,615,234).

With respect to claim 5, Eldridge et al. discloses a document delivery apparatus according to claim 1, wherein the at least one server comprises a document management server (104 Network File Server 104 and Shared Document Server 134 of Fig 1) that manages documents, and wherein the document delivery apparatus (Token Enabled Servers 126 comprising Document Delivery Server 138 of Fig 1 and col 5, lines 41-45) further comprises control means.

Eldridge et al. does not disclose wherein the document delivery apparatus comprises control means operable when the received document is delivered to the document management server, for notifying by electronic mail to at least one

predetermined electronic mail address that the document information has been registered.

Adamske et al. does disclose notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered (col 4, lines 30-39).

Eldridge et al. and Adamske et al. are analogous art, because they are from the same field of endeavor, namely Document Delivery.

At the time of the invention, it would have been obvious for one skilled in the art to combine Eldridge et al's document delivery apparatus according to claim 1, wherein the delivery destination for the received document information comprises a document management server, with Adamske et al's notifying by electronic mail to at least one predetermined electronic mail address that the document information has been delivered.

The suggestion or motivation for doing so would have been to explicitly state that an email notification is sent out to at least one predetermined electronic mail address that the document information has been registered.

Claim 15 recites identical features as claim 5 except claim 15 is a method claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 15.

Claim 25 recites identical features as claim 5 except claim 25 is a computer-readable medium claim. Thus, arguments similar to that presented above for claim 5 are also equally applicable to claim 25. The examiner further notes that it is necessarily



inherent that the Document Delivery Servers (128 and 138 of Fig 1) comprise some type of memory or computer-readable medium to function.

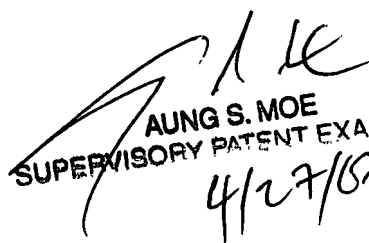
**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Scott A. Schlack

  
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SUPERVISORY PATENT EXAMINER  
4/27/07